

REMARKS

This is in response to the Office Action mailed on April 23, 2003, in which claims 2, 3, 6-10, 12-14 and 17 were rejected, claims 4, 5, 15 and 16 were objected to, and claims 19-27 were allowed. Claims 2-10, 12-17 and 19-27 are pending in this application.

Claims 2, 6, 12-14 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Smeenge et al. (U.S. Patent No. 4,616,798) in view of Martin (U.S. Patent No. 5,732,910) and in further view of Meier et al. (U.S. Patent No. 5,830,552). Claims 3, 6 and 7-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bateson (U.S. Patent No. 6,123,304) in view of Martin (U.S. Patent No. 5,732,910) and in further view of Meier et al. (U.S. Patent No. 5,830,552).

A. Claims 2, 6, 12-14 and 17

The Examiner rejected claims 2, 6, 12-14 and 17 by combining the teachings of Smeenge et al., Martin and Meier et al. The Examiner stated that Smeenge et al. disclose an adjustable keyboard tray comprising a tray (11) having a top plate and a bottom plate, and a mounting plate (50). The Examiner noted that Smeenge et al. fail to disclose that the tray is formed from two separate elements, namely a top and bottom plate, that are ultrasonically welded together.

The Examiner then turned to the disclosure of Martin, stating that Martin teaches a keyboard tray comprising two parts, namely a top plate (21) and medial plate (22) of the tray forming a cavity therebetween. The Examiner contended that it would have been obvious to have substituted the keyboard tray as taught by Martin for the keyboard tray as taught by Smeenge et al. as "mere functional equivalent parts for the purpose of supporting a keyboard thereupon while simultaneously supporting a mouse thereupon."

Finally, the Examiner combined the teachings of Meier et al. with the teachings of Smeenge et al. and Martin, stating that Meier teaches a planar structure having polymeric components that are welded together by ultrasonic or high frequency, etc. (See col. 6, lns. 14-20).

As discussed in detail below, the combination of references cited by the Examiner fails to disclose all of the elements of the claims, and the combination is impermissible because of

the lack of any suggestion or motivation to combine the teachings of the references to yield the claimed invention.

1. Independent Claims 2 and 13

Independent claims 2 and 13 recite an adjustable keyboard tray for use with a center mount bracketing mechanism that is secured to and translates in and out from a horizontal surface. The tray includes a top plate made of polymeric material and a bottom plate made of polymeric material that is secured to the top plate. A mounting plate secures the tray to the bracketing mechanism, the mounting plate being secured to the bottom plate of the tray in a recessed mounting area to maintain a substantially smooth outer surface along the bottom plate.

a. Requirements for Prima Facie Obviousness

Three basic requirements are necessary to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See M.P.E.P. 2143.

b. All Claim Limitations Must be Taught or Suggested

In order to reject a claim under 35 U.S.C. 103 as being obvious, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1964). Thus, all of the features of claims 2 and 13 must be taught or suggested by Smeenge et al., Martin or Meier et al. in order to properly reject those claims.

The Examiner's proposed combination of these references would not disclose all of the recited elements of claims 2 and 13. Claims 2 and 13 recite a mounting plate that secures the tray to a bracketing mechanism, wherein the mounting plate is secured to the bottom plate of the tray in

a recessed mounting area to maintain a substantially smooth outer surface along the bottom plate. Neither the Smeenge et al. apparatus nor the Martin apparatus secures a mounting plate in a recessed mounting area, nor is there any indication in either patent how the disclosed apparatus might be modified to allow a mounting plate to be secured in a recessed mounting area to maintain a substantially smooth outer surface along the bottom plate. The Smeenge et al. apparatus is mounted by a protruding bracket (see FIG. 2), which is not set in a recessed mounting area and does not maintain a smooth outer bottom surface. The Martin apparatus is not mounted at all (it is supported on the lap of a user by foam lower member 23). Therefore, since the combination of Smeenge et al., Martin and Meier et al. does not disclose all of the recited elements of claims 2 and 13, the rejection of claims 2 and 13 under 35 U.S.C. 103(a) should be withdrawn.

c. A Teaching or Suggestion to Combine Teachings is Required

In order to combine multiple prior art references as the basis of an obviousness rejection, there must be some suggestion or motivation, either in the references themselves or elsewhere in the art, to combine the teachings of the references. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. 2143.01, citing In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

There is no teaching or suggestion to combine the teachings of Smeenge et al. and Martin in such a manner as to yield the present invention as recited in claims 2 and 13. The keyboard support apparatus of Martin is designed to be placed on the lap of a user, and as such includes a lower foam member (23) that covers the bottom surface of the tray to support the tray on the user's lap. The proposed combination of Smeenge et al. and Martin would remove the foam lower member (23) from the Martin tray, using only the top member (21) and the medial member (22) of the tray, and would employ those parts to replace the mounted keyboard tray of Smeenge et al. There is no suggestion or motivation for this selective combination of parts. There is no teaching or suggestion anywhere in the references that the top member (21) and medial member (22) of

Martin can be removed from the lower foam member (23) that supports the tray. The Examiner has proposed a modification of the Martin apparatus that, while being physically possible, is not taught or suggested by the prior art to be desirable. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. 2143.01, citing In re Mills, 16 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 1990). Thus, the top (21) and medial (22) members of Martin cannot be separated from the lower foam member (23), since the lower foam member is not simply an interchangeable mounting mechanism, but an integral part of the Martin support apparatus. For at least these reasons, the combination of Smeenge et al. and Martin is not a proper one, and the rejection of claims 2 and 13 under 35 U.S.C. ' 103 should accordingly be withdrawn.

2. Dependent Claims 6 and 12

Claim 6 depends from either claim 2 or claim 3. For the purpose of its dependency from claim 2, claim 6 is allowable with its parent claim 2. In addition, it is respectfully submitted that the combination of features recited in claim 6 is patentable on its own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claim 12 depends from either claim 13 or claim 14. For the purpose of its dependency from claim 13, claim 12 is allowable therewith. In addition, it is respectfully submitted that the combination of features recited in claim 12 is patentable on its own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

3. Independent claim 14

Independent claim 14 recites an adjustable keyboard tray for use with a bracketing mechanism that is secured to and translates in and out from a horizontal surface. The tray includes a top plate and a bottom plate secured to the top plate, as well as a mounting plate secured to the adjustable keyboard tray by a retaining bracket, such that the adjustable keyboard tray can slide in a lateral direction substantially perpendicular to the direction of translation by the bracketing mechanism. As was discussed above with respect to claims 2 and 13, there is no suggestion or motivation to replace the keyboard tray of Smeenge et al. with only a selected portion of the apparatus taught by Martin in order to construct an adjustable keyboard tray that includes top and bottom plates with a cavity therebetween. In addition, neither Smeenge et al. nor Martin teach a mounting plate that can slide in a lateral direction substantially perpendicular to the direction of translation by a bracketing mechanism, as recited in claim 14. The Smeenge et al. apparatus only pivots around an axis (see FIG. 8, for example), and the Martin apparatus is not mounted at all. Since the combination of Smeenge et al., Martin, and Meier et al. does not disclose all of the features recited in claim 14, and since the combination of references is improper because of the lack of suggestion or motivation to do combine the teachings of the references, the rejection of claim 14 under 35 U.S.C. 103(a) should be withdrawn.

4. Dependent Claim 17

Claim 17 depends from claim 14, and is allowable therewith. In addition, it is respectfully submitted that the combination of features recited in claim 17 is patentable on its own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

B. Claims 3, 6 and 7-10

The Examiner rejected claims 3, 6 and 7-10 by combining the teachings of Bateson, Martin, and Meier. The Examiner stated that Bateson discloses an adjustable keyboard tray

comprising a tray (18) and a mounting plate (12), with the mounting plate securing the adjustable keyboard tray to a bracketing mechanism (14). The Examiner noted that Bateson does not disclose that the tray is formed from two separate elements, namely top and bottom plates. The Examiner then turned to the disclosures of Martin and Meier, as has been discussed above with respect to claims 2 and 13.

1. Independent Claim 3

Independent claim 3 recites an adjustable keyboard tray for use with a center mount bracketing mechanism that is secured to and translates in and out from a horizontal surface. The tray includes a top tray and a bottom tray secured to the top tray. A mounting plate secures the tray to the bracketing mechanism, wherein the mounting plate is secured to the tray by a retaining bracket.

a. All Claim Limitations Must be Taught or Suggested

In order to reject a claim under 35 U.S.C. 103 as being obvious, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1964). Thus, all of the features of claim 3 must be taught or suggested by Bateson, Martin or Meier et al. in order to properly reject that claim. The Examiner's proposed combination of these references would not disclose all of the recited elements of claim 3. Claim 3 recites an adjustable keyboard tray for use with a center mount bracketing mechanism that is secured to and translates in and out from a horizontal surface. Claim 3 further recites a mounting plate that secures the tray to the bracketing mechanism. The Examiner has identified the support shelf (12) of Bateson as the claimed mounting plate, and has identified the rails (14) on which the shelf (12) slides as the claimed center mount bracketing mechanism. However, the rails (14) do not translate in and out from a horizontal surface, as required of the center mount bracketing mechanism recited in claim 3. It is the shelf (12) that translates in and out according to the teachings of Bateson. The shelf (12) cannot be both the claimed bracketing mechanism and the claimed mounting plate, since the claim specifically recites that the mounting plate secures the tray to the bracketing mechanism. Martin does not remedy this deficiency, since the Martin keyboard tray is not mounted at all (it is

supported on the lap of a user by foam lower member 23). Therefore, since the combination of Bateson, Martin and Meier et al. does not disclose all of the recited elements of claim 3, the rejection of claim 3 under 35 U.S.C. 103(a) should be withdrawn.

b. A Teaching or Suggestion to Combine Teachings is Required

In order to combine multiple prior art references as the basis of an obviousness rejection, there must be some suggestion or motivation, either in the references themselves or elsewhere in the art, to combine the teachings of the references. See M.P.E.P. 2143. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. 2143.01, citing In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

There is no teaching or suggestion to combine the teachings of Bateson and Martin in such a manner as to yield the present invention as recited in claim 3. The keyboard support apparatus of Martin is designed to be placed on the lap of a user, and as such includes a lower foam member (23) that covers the bottom surface of the tray to support the tray on the user's lap. The proposed combination of Bateson and Martin would remove the foam lower member (23) from the Martin tray, using only the top member (21) and the medial member (22) of the tray, and would employ those parts to replace the mounted keyboard shelf of Bateson. There is no suggestion or motivation for this selective combination of parts. There is no teaching or suggestion anywhere in the references that the top member (21) and medial member (22) of Martin can be removed from the lower foam member (23) that supports the tray. The Examiner has proposed a modification of the Martin apparatus that, while being physically possible, is not taught or suggested by the prior art to be desirable. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. 2143.01, citing In re Mills, 16 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 1990). Thus, the top (21) and medial (22) members of Martin cannot be separated from the lower foam member (23), since the lower foam member is not simply an interchangeable mounting mechanism, but an integral part

of the Martin support apparatus. For at least these reasons, the combination of Bateson and Martin is not a proper one, and the rejection of claim 3 under 35 U.S.C. 103 should accordingly be withdrawn.

2. Dependent Claims 6-10

Claim 6 depends from either claim 2 or claim 3. For the purpose of its dependency from claim 3, claim 6 is allowable with its parent claim 3. In addition, it is respectfully submitted that the combination of features recited in claim 6 is patentable on its own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claims 7-10 depend from claim 6, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 7-10 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Objections to Claims

Claims 4, 5, 15 and 16 were objected to as being dependent on rejected base claims, but were otherwise indicated to be allowable. In view of the foregoing, the base claims from which claims 4, 5, 15 and 16 depend are in condition for allowance, and claims 4, 5, 15 and 16 are allowable therewith.

Allowed Claims

The allowance of claims 19-27 is gratefully acknowledged.

New Claims

With this Amendment, new dependent claims 28 and 29 have been added to recite that the top and bottom plates are secured together by ultrasonic welding. Based on a review of independent claims 2 and 3 in view of the prior art cited by the Examiner, this limitation is being

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removed from independent claims 2 and 3 as not being necessary to patentably distinguish those claims from the prior art of record. Consideration and allowance of new claims 28 and 29 are respectfully requested.

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CONCLUSION

In view of the foregoing, all pending claims 2-10, 12-17 and 19-29 are now in condition for allowance. A notice to that effect is respectfully requested.

Respectfully submitted,

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